

REMARKS

The application has been amended and is believed to be in condition for allowance. The instant amendment is submitted concurrently with a Request for Continued Examination ("RCE").

Amendments to the Disclosure

Claims 1, 13 and 14 are amended to recite an apparatus being portable; the amendment finds support in the specification and the drawing figures as originally filed (e.g., page 2, lines 14-16; page 6, lines 6-7). Claim 13 is further amended to expressly recite that the data stream is recorded in a memory device (e.g., page 6, lines 1-2).

New dependent claims 19-22 are introduced to further distinguish the invention over the prior art.

New claim 19 depends from claim 1 and finds support at least at page 6, lines 1-5 of the specification and Figure 1 as originally filed.

New claim 20 depends from claim 13 and finds support at least at page 2, lines 11-12 and lines 21-29; and page 3, lines 4-8 of the specification as originally filed.

New claims 21 and 22 depend from respectively from claims 19 and 20 and find support in the specification at page 2, lines 10-14; and page 3, lines 4-8.

Based on the foregoing, it is respectfully submitted that the claim amendments are proper.

Formal Matters - Section 101

The Official Action rejected claims 14-15 under 35 USC 101 as being directed to non-statutory subject matter. The Official Action also states that "Claims 1-10 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing." Applicant understands, however, that the foregoing statement applies to claims 14-15 and not to claims 1-10 as i) claims 1-10 are not directed to a process, ii) the Official Action specifically references method steps in the second paragraph of page 3, and iii) dependent claims 11-13 and 16-18 are not included in the statement.

The Applicant understands the Official Action to state that the method steps of claims 14-15 are not tied to a particular machine and do not perform a transformation. Although the apparatus is itself a machine, the claim comprises a method of transmitting the actual apparatus, and then the data from the apparatus, but the method itself is not tied to the apparatus.

In response, claim 14 is amended and believed to be statutory under Section 101.

Under Section 101, any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. As is well known, the categories identified as being non-statutory under Section 101 are limited to abstract ideas, laws of nature and natural phenomena. The burden is on the Patent Office to set forth a prima facie case of unpatentability. MPEP 2106, § IV(A-B).

Here, claim 14 recites, in part, a method tied to a physical movement and operation of at least one inspection apparatus, including the steps of distributing a plurality of said apparatuses over a space or territory, providing at least one of said apparatuses to a person such that said person triggers or operates one or more components of the device to perform various functions. In particular, the method does not recite purely mental steps. On the contrary, the method requires physical acts upon a physical apparatus.

It is therefore respectfully submitted that claim 14 is neither directed to nor restricted to any of an abstract idea, a law of nature, or a natural phenomena.

Accordingly, it is respectfully submitted that claim 14 is statutory under Section 101. It is further respectfully submitted that claims depending from claim 14 are statutory at least for depending from a statutory claim.

Substantive Issues - Section 103

The Official Action rejected claims 1-18 as being unpatentable over Rhoads et al. (U.S. Patent Pub. No. US 2002/0122564 A1; "RHOADS") in view of Snapp et al. (U.S. Patent Pub. No. US 2003/0069693 A1; "SNAPP").

The rejections are respectfully traversed for at least the reasons that follow.

It is firstly respectfully submitted that the combination of RHOADS and SNAPP fail to teach all the features recited in the independent claims.

As to claim 1, the Official Action offers RHOADS as teaching a CPU (paragraph [0101]; a computer) and at least one digital audiovisual device configured to make an audiovisual recording (paragraph [0102]; digital camera).

However, it is respectfully submitted that RHOADS does not teach or suggest these features being both contained in a compact, portable and secure casing, as required by claim 1. On the contrary, paragraph [0101] discloses a computer or workstation with a large disk library and capable database software for the purpose of registration, watermarking, and other operations upon large volumes of data. Paragraph [0102], on the other hand, discloses equipping an imaging instrument with an optical shutter that imparts a watermark to an image finds application in digital cinema. There is no

teaching or suggestion of a structure combining these features together in a portable apparatus.

There is further no suggestion for a structure combining these teaching, either in RHOADS or in SNAPP. As disclosed in paragraphs [0017]-[0056], a computer with a large disk library and capable database software is directed toward the management of large numbers of aerial images. There is no teaching or suggestion of the computer and database taught by RHOADS toward any other application, particularly not an integration with an audiovisual device within a compact, portable, and secure enclosure.

It is therefore respectfully submitted that the computer or workstation of paragraph [0101] and the image instrument of paragraph [0102] are not expected to be found in a single apparatus (they are only part of distinct embodiments) and combining these two feature is in itself not taught or suggested by either of the applied references. Accordingly, it is respectfully submitted that the applied references fail to teach all the features recited by claim 1.

In addition, the Official Action offers paragraph [0047] as teaching a clock configured to provide temporal information. However, as above with respect to the teaching of a database, the watermarking and identification of date/time of data acquisition is directed to management of data, as expressly disclosed in paragraphs [0008]-[0010]

(e.g., coping with the problem of having a huge quantity of aerial imagery, and tracking the images that can be pieced together). This teaching would not have led one of skill toward the portable device containing the devices recited in claim 1.

It is further respectfully submitted that one of skill would have had no reasonable motivation to combine RHOADS with SNAPP to arrive at the invention recited by claims 1, 13, and 14.

The Official Action on page 4 concedes that RHOADS does not teach a compact and secure casing, positionable at a required height and inclination. The Official Action contends that it would have been obvious at the time of the invention for one of skill to have used a tamper resistant casing as taught by SNAPP to "make the inspection apparatus tamper resistant," making reference to SNAPP paragraph [0062].

Applicant respectfully disagrees.

It is firstly respectfully submitted that RHOADS does not teach an inspection apparatus. On the contrary, RHOADS is directed toward applications of digital watermarking to help track such imagery, provide an audit trail, serialization, anti-copying, and other benefits (paragraph [0009]). Data imagery, including images having unique features, may be pieced together using embedded data or data indexed via embedded data, and a so-called "geovector" may be

carried by or indexed with a digital watermark (paragraph [0010]).

The only physical embodiment of a portable imaging device incorporating watermarking technology is disclosed as "equipping an imaging instrument with an optical shutter that imparts a watermark to an image finds application in digital cinema (e.g., in watermarking a theatrical movie with information indicating the theatre's geo-location, date, time, and/or auditorium of screening)," (paragraph [0102]).

This does not disclose an "inspection apparatus" or any other device one of skill would have any reasonable motivation to make tamper resistant.

As is well known, the conclusion of obviousness is not sufficient merely because the references relied upon allegedly teach that substantially all aspects of the claimed invention were individually known in the art; an objective reason to combine the teachings of the references must be articulated with some rational underpinning to support the legal conclusion of obviousness. MPEP § 2143.01, paragraph IV. "When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious." *KSR v Teleflex*, 82 USPQ2d at 1395. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the

proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984; emphasis added).

SNAPP is directed to a portable system for accessing data correlated with a geographic location, such as the content of a guidebook, so that users receive information related to their physical location (e.g., paragraph [0058]). Although SNAPP discloses an apparatus with a digital camera, SNAPP makes no teaching or suggestion of securing any images acquired through the camera. SNAPP, at best, discloses attaching a tag to a file in order to identify a user who has worked on a file (paragraph [0063]). No watermark is disclosed, and no inspection apparatus is suggested.

The Official Action contends that one of skill would have been motivated by SNAPP to make the apparatus of RHOADS tamper-proof. However, RHOADS one of skill would have readily understood that such a modification would render RHOADS unsatisfactory for its intended purpose. Except for the embodiment taught in RHOADS paragraph [0102], RHOADS does not suggest either of a portable apparatus or an apparatus that would benefit from additional structure and complication of tamper-proofing.

For example, the incorporation of tamper-proofing into a computer workstation as described in paragraph [0101] would place "a large disk library" of images stored for the purpose of management and coordination at risk of destruction

should the workstation need routine maintenance. Unlike the portable apparatus disclosed by SNAPP for distribution to consumers in the field, the workstation of RHOADS is readily understood to be for professional use and for reliable storage of the data to be managed.

Similarly, the embodiment in paragraph [0102] would be rendered unsatisfactory by a modification in accordance with SNAPP. Here, the result of the combination would be a cinematic movie camera that cannot be opened without the camera and its footage being destroyed.

Neither of the embodiments above as offered by the Official Action teach or suggest an inspection apparatus.

The application of a security measure as contemplated by SNAPP would have been no small matter to one of skill in combining with another application. Generally, security features as disclosed by SNAPP are undesirable except in special applications that absolutely demand data integrity, such as consumer units carrying copyrighted or branded content (e.g., SNAPP paragraph [0178]). No embodiment of RHOADS is suggested as being appropriate for such a modification, in particular because RHOADS makes no disclosure of an inspection apparatus.

Based on at least the reasonings set forth above, it is respectfully submitted that a reasonable motivation does not exist to have combined RHOADS with SNAPP at the time of

invention. Accordingly, obviousness is not shown with respect to claims 1, 13 and 14.

Therefore, it is respectfully submitted that claims 1, 13, and 14 are patentable over the references applied by the Official Action.

It is further respectfully submitted that claims depending from independent claims 1, 13 and 14 are patentable at least for depending from patentable parent claims.

For example, it is respectfully submitted that new claims 19 and 20 are neither taught nor suggested by the applied references, individually or in combination.

At best, paragraphs [0070] and [0071] of RHOADS teach error correction coding of a watermark's binary message and combining the binary message with a carrier signal to create a component of a watermark signal. There is no teaching or suggestion of an extraction of a data resulting from the data stream out of a secure casing using a secure method.

Therefore, it is respectfully submitted that claims 19 and 20 are patentable in their own right, in addition to being dependent from patentable parent claims.

From the foregoing, it will be apparent that Applicant has fully responded to the July 24, 2009 Official Action and that the claims as presented are patentable. In

view of this, Applicant respectfully requests reconsideration of the claims, as presented, and their early passage to issue.

In order to expedite the prosecution of this case, the Examiner is invited to telephone the attorney for Applicant at the number provided below if the Examiner is of the opinion that further discussion of this case would be helpful in advancing prosecution.

Please charge the fee of \$52 for the two extra claims of any type added herewith, to our credit card.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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